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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,299	12/01/2003	Mark L. Anderson	01639.000014.	6104

5514 7590 03/03/2006

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER	
MCCORMICK EWOLDT, SUSAN BETH	
ART UNIT	**PAPER NUMBER**
1655	

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/726,299	ANDERSON ET AL.	
	Examiner	Art Unit	
	S. B. McCormick-Ewoldt	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 February 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *20-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *20-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 9, 2006 has been entered.

Election/Restriction

Applicant elected species, grape seed extract, election in the reply filed on January 11, 2005.

Claims Pending

Applicant has cancelled claims 1-19 in the Office action dated October 31, 2005 and added claims 20-23. Currently, claims 20-23 will be examined on the merits solely in regard to the elected species.

Applicant's arguments pertaining to the previous rejection are moot in light of the new rejections which follow.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Written Description

Claims 20-23 either recite, or depend upon a claim which recites "grape seed extract and green tea extract." It is deemed that Applicant has not set forth a representative number of examples in order to reasonably verify possession of such a potentially enormous number of extracts.

The MPEP states that written description for a genus can be achieved by a representative number of species within a broad generic. It is unquestionable that the claims are broad generics, with respect to *all* extracts. The possible variations of extracts are limitless. Although Applicant has disclosed solvents which could potentially be used to "extract grape seed and green tea" (p. 7 of specification) this disclosure is actually a *very few* number in comparison to the enormous, *potentially millions* of types of extracts which could be obtained from grape seed and green tea. The reason for this large amount of permutations is because extraction techniques are often coupled in order to obtain a product; for example

1) a water extraction followed by an alcoholic extraction: the product obtained is an extract.

2) a supercritical extraction (CO_2) followed by an alcoholic and then a non-polar solvent extraction (e.g., chloroform): the product is an extract.

3) a benzene extraction followed by a water extraction and chromatographic separation: the product is an extract.

4) a water/chloroform extraction (e.g., in a seperatory funnel), followed by collection of the water layer, chromatographic separation and crystallization of an isolate: the product is an extract.

5) squeezing the plant to obtain a juice: the product is an extract.

6) dipping the plant in an organic solvent to remove the waxy layer: the product is an extract.

The MPEP states that the purpose of the written description requirement is to ensure that the invention had possession, as of the filing date of the application, of the specific subject matter later claimed by him or her. The courts have stated:

"To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention." Lockwood v. American Airlines, Inc., 107 F. 3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); *In re Gostelli*, 872 F. 2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) ("[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an Applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, no that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." Lockwood, 107 F. 3d at 1572, 41 USPQ2d at 1966. Regents of the University of California v. Eli Lilly & Co., 43 USPQ2d 1398. The specification lacks sufficient variety of species of extracts to reflect this variance in the genus since the specification does not provide sufficient examples of such a genus of extracts.

The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder*, 736, F. 2d 1516, 1521, 222 USPQ 369, 372-73 (Fed. Cir. 1984) (affirming rejection because the specification does "little more than outline [goals] appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate.") Accordingly, it is deemed that the specification fails to provide adequate written description for the genus of "extract" and does not reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed had possession of the entire scope of the claimed invention and thus, this rejection is proper.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Internet website Huddleston (2000) in view of Cui *et al.* (KR 2003073441- abstract only) in view of Wada (JP 408092028-abstract only).

Internet website Huddleston (2000) discloses that green tea has shown to be an antibacterial and proven to have the ability to kill Bacterium acne, the bacteria that causes acne (page 2, second paragraph) .

Internet website Huddleston (2000) does not disclose wherein the green tea extract is combined with grape seed extract or 1,3-butylene glycol.

Cui *et al.* (KR 2003073441) disclose that *Vitis vinifera* (i.e. grape) extract contains tannins that are antibacterial and have an effect against *Propionibacterium acne* and is used in an antibacterial composition (see abstract).

Wada (JP 408092028) disclose that 1,3-butylene glycol is used as a humectantin a cosmetic in inhibiting and the effects of acne vulgaris (see abstract).

One of ordinary skill in the art would have been motivated to add grape seed extract and green tea extract into a topical composition to treat acne because grape seed extract and green tea extract are known to have antibacterial properties and would be advantageous to be used in compositions that treat acne. It was clear from Huddleston (2000) that green tea extracts have antibacterial properties and have been used to treat acne. It was further clear from Cui that *Vitis vinifera* contains antibacterial effects which are used against Propionibacterium acne and it was further clear from Wada that 1,3-butylene glycol is used in compositions that treat acne. It is clear that the combination of extracts would have been effective in treating *Propionibacterium acne* and Bacterium

acne. Therefore, one of ordinary skill in the art would have had a reasonable expectation that, because of their beneficial anti-microbial properties, to combine grape seed extract and green tea extract in a composition to treat acne.

These references show that it was well known in the art at the time of the invention to use grape seed extract and green tea extract in a composition to treat acne. It is well known that it is *prima facie* obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. *In re* Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); *In re* Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); *In re* Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

Based on the disclosure by these references that grape seed extract and green tea extract are used in compositions to treat acne, an artisan of ordinary skill would have a reasonable expectation that a combination consisting essentially of grape seed extract and green tea extract would be useful for treating acne. Therefore, the artisan would have been motivated to combine the claimed ingredients into a single composition. No patentable invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients. See *In re* Sussman, 1943 C.D. 518; *In re* Huellmantel 139 USPQ 496; *In re* Crockett 126 USPQ 186.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention.

Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Summary

No claim is allowed.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiners' supervisor, Terry McKelvey, can be reached at (571) 272-0775. The official fax number for the group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sbme

PATRICIA LEITH
PRIMARY EXAMINER